UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
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Ex parte WILLIAM THOMPSON

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Appeal No. 1997-0810
Application No. 08/512,072[1]
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ON BRIEF
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Before HAIRSTON, FLEMING and HECKER, Administrative Patent
Judges.

HECKER, Administrative Patent Judge.

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[1] Application for patent filed August 7, 1995. According
to appellant, this application is a continuation of
Application No. 08/276,753, filed July 18, 1994, now
abandoned; which is a continuation of Application No.
08/065,337, filed May 24, 1993, now abandoned.

DECISION ON APPEAL

This is a decision on appeal from the final

rejection of claims 1 through 4, all claims pending in this

application.   The invention relates to binary data

displays, and more particularly to an adaptive cursor for

interpreting displays of grouped data segments within

unformatted groups of data bits.

Representative independent claim 1 is reproduced as

follows:

1.   A method of displaying an adaptive cursor for
unformatted groups of binary data comprising the steps of:

extracting from a serial digital input signal bits
for the unformatted groups of binary data, each group forming
an ancillary block of data;

displaying a selected one of the ancillary blocks of
data in binary form;

manually positioning a marker cursor at a bit
position within the selected ancillary block of data;

determining from a stored format for the selected
ancillary block of data the bits associated with the bit
position that form a segment within the selected ancillary
block of data; and

automatically simultaneously highlighting on the display the bits of the segment within the selected ancillary block of data as the adaptive cursor.

The Examiner relies on the following references:

Ho   4,747,058   May 24, 1988
Wroblewski et al. (Wroblewski)   5,339,391   Aug. 16, 1994
                                                (effective filing date May 14, 1990)
Appellant's admitted prior art (APA)

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellant's admitted prior art (APA) in view of Ho and further in view of Wroblewski.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for the respective details thereof.

<u>OPINION</u>

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 4 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie***
case. It is the burden of the Examiner to establish why one
having ordinary skill in the art would have been led to the
claimed invention by the reasonable teachings or suggestions
found in the prior art, or by a reasonable inference to the
artisan contained in such teachings or suggestions. ***In re
Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).
"Additionally, when determining obviousness, the claimed
invention should be considered as a whole; there is no legally
recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v.
SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237,
1239 (Fed. Cir. 1995) (***citing W. L. Gore & Assocs., Inc. v.
Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed.
Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984)).

With regard to the rejection of claim 1, the
Examiner states that the APA discloses the claimed invention
including the step of extracting (lines 3 and 4), the step of
displaying (line 5) and the step of determining (lines 8-10).
The Examiner then combines Ho with the APA to obtain the
claimed steps of manually positioning a marker (lines 6 and 7)

and highlighting (lines 11 and 12). For "simultaneously"

highlighting, the Examiner adds Wroblewski to the combination.

(Answer-pages 4-6.)

Appellant agrees with the Examiner with respect to

the step of extracting and displaying being disclosed in the

APA, but takes issue with the determining step. (Brief-page

4.)

Appellant states:

> Certainly for a manual operation an operator, if he
> takes the time to identify which bit number is being
> marked by counting the bits, can then refer to a
> printout of the format and determine what bits make
> up the segment of which the marked bit is a part.
> But the invention is not concerned with a manual
> operation, as **is readily apparent from the
> specification**. Therefore Applicant submits that the
> APA does not teach or suggest the determining step
> as recited in claim 1. (Brief-page 4.) (Emphasis
> added.)

This argument fails at the outset because Appellant

admits the APA teaches "determining" but relies on the

specification to avoid a "manual determination". Since the

claim language does not prohibit a "manual determination",

this argument is not based on a limitation appearing in the

claim and is immaterial. See **In re Self**, 671 F.2d 1344, 1350,

213 USPQ 1, 5 ((CCPA 1982).

> With regard to the claim 1 limitation of

> manually positioning a marker cursor at a bit
> position within the selected ancillary block of
> data;

Appellant argues:

> Ho teaches that after a first character is
> corrected, the operator presses a key ("enter")
> which causes the cursor to move to the next <u>misread</u>
> character (emphasis added). This is not the same as
> having a marker cursor that can be placed on "a bit
> position" of a binary display, i.e., any bit
> position, as recited in claim 1. (Brief-page 5.)

> We agree with Appellant that Ho does not teach

manually positioning a marker. Ho's marker is placed

automatically. Although the operator manually presses a key

to move to the next misread character, the next misread

character and its bit position, is selected by the system, not

the operator. Thus, this claim limitation is not met by Ho.

Also, the Examiner admits that manual positioning is not

disclosed in the APA (answer-bottom of page 4), and does not

rely on Wroblewski for this teaching. Since manual

positioning of the marker cursor is not taught or shown to be

obvious over the references of record, we will not sustain the

rejection of claim 1. Likewise, claims 2 and 3, dependent

from claim 1, include the same unmet limitation, and we will

not sustain the rejection of these claims.

Additionally, claim 4 recites the same unmet limitation in

lines 8 and 9, therefore we will not sustain the rejection of

this claim.

        We note that Appellant argues impermissible

hindsight in combining APA, Ho and Wroblewski, stating "One

dealing with binary data signals would not look to document

devices based upon character reading as a source of

inspiration." (Brief-page 6.) We disagree. The title of

Appellant's invention is "Adaptive Cursor for Interpreting
Displays of Grouped Data Words." Ho is a "Code Line Display
System" and Wroblewski is a "Computer Display Unit with
Attribute Enhanced Scroll Bar". All three deal with display
markers and highlighting associated bits.

        We have not sustained the rejection of claims 1
through 4 under 35 U.S.C. § 103. Accordingly, the Examiner's
decision is reversed.

<u>REVERSED</u>

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                   KENNETH W. HAIRSTON   )
                   Administrative Patent Judge   )
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